

## **REMARKS**

### **A.     Objection to Title**

In the Office Action of June 1, 2005, the title was objected to for not being descriptive. Applicant traverses the objection in that the title is descriptive. Despite the impropriety of the objection, the title is being amended in the present Amendment to read as "Position Measuring System" as suggested by the Examiner. Accordingly, the objection should be withdrawn.

### **B.     35 U.S.C. § 112, Second Paragraph**

Claims 1, 6, 7 and 12 were rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. In particular, claims 1 and 6 were rejected because it was vague and indefinite how the measuring system is controlled via the generated error signal. Applicant traverses this rejection for several reasons. First, there is no requirement under 35 U.S.C. § 112, second paragraph, to recite "how" a claimed invention performs a particular function. All that matters under 35 U.S.C. § 112, second paragraph, is whether or not the claims are clear in meaning. Since the rejection fails to point to any words or phrases in claims 1 and 6 that are vague and indefinite, the claim is improper.

Second, Applicant traverses the rejection because it appears to be an attempt by the Patent Office to require the Applicant to recite some type of control feature. This is improper. It is up to the Applicant alone to state what he or she believes is patentable. *In*

*re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As long as the prior art allows it, Applicant is free to define his or her invention as broadly as the prior art allows. In the present case, the Office Action has not cited any art as to the patentability of claims 1 and 6 and so Applicant's claims are proper as to their breadth.

For the above reasons, Applicant respectfully asserts that the rejection has no merit and so should be withdrawn. Since claims 1, 6, 7 and 12 have not been rejected based on the prior art, they should be allowed as well.

On a related matter, it is noted that the rejection appears to be using the word "control" to mean that the error signal manipulates the position measuring system in some way. However, as used in Applicant's Specification "functional control" means that the proper functioning of the position measuring device is monitored to see if the device is operating correctly. Obviously, the generation of an error signal informs the user that the device is not operating correctly.

**C. Claims 2-5 and 8-11**

Applicant notes with appreciation that claims 2-5 and 8-11 have been indicated to contain allowable subject matter. Accordingly, claims 2 and 8 have been rewritten in independent form and so they should be allowed along with their dependent claims 3-5 and 9-11.

As mentioned above, claims 2 and 8 have been amended so as to be in

independent form. Since the amendments incorporate subject matter that was inherently present in the original claims, the amendments are not related to patentability. *See, Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 535 U.S. 722 (2002).

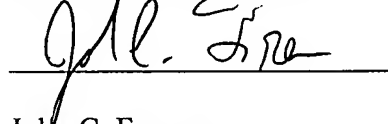
It is noted that a statement of reasons for allowance for claims 2-5 and claims 8-11 are given in the Office Action. Applicant traverses the statement in that there are broader and/or additional reasons why the claims are patentable. In addition, the statement regarding claims 2-5 and 8-11 makes mention of terms that are not present in the claims, such as 1)  $A = a + \text{signal}$  (claims 8-11), 3600 degree (claims 2-5 and 8-11) and  $z$  (claims 8-11).

### **CONCLUSION**

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-12 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office

Action and believes that an interview would be helpful to resolve any remaining issues,  
he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "John C. Freeman", is written over a horizontal line.

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